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John H. Bouchard
Schlumberger Technology Corporation
Suite 1700
5599 San Felipe
Houston, TX 77056-2722

EXAMINER

BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
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3629

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05/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/004,603	Applicant(s) DECATUR, STEPHEN H.	
	Examiner Matthew L. Brooks	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Information Under 37 CFR § 1.105

1. MPEP 704.10 → 37 CFR 1.105. Requirements for information.

(a)

(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, Examiner is asking for:

(i) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) Search : Whether a search of the prior art was made, and if so, what was searched.

(iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) **Technical information known to applicant . Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner 's stated interpretation of such items.**

1. This is a request that applicants provide the information identified above and below especially where emphasis added. If applicants have this information, then applicants are required, under the provisions of 37 CFR 1.56, to disclose the information to the Office. A copy of 37 CFR 1.56 is enclosed for the convenience of the applicants.

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2. Applicants are not required or being asked to conduct a search for information beyond applicants own immediate files and/or knowledge. If applicants do not have immediate knowledge of the information requested, then a statement that the information sought is unknown or not readily available to the applicants will be accepted by the office as a complete reply.

3. **Why the Request for Information is Reasonably Necessary** -

Applicant has claimed the subject matter requested in claims 3, 6, 8, and 10.

4. **Information Requested of Applicants:** Are you aware of (1) when you or applicant is viewing seismic data/report or when a landman presents to a buyer OR has Shclumberger been required when dealt with a landman or surveyor in the past, a viewer/buyer of said data is forced to sign confidentiality agreements and or pay more money in order to see survey exploration reports or raw seismic data. Again that is to say, has Applicant in the past been forced to pay money or sign a confidentiality agreement? AND/OR (2) has the Applicant had to agree to an interest owner conditions of restricted use and disclosure of detailed property report/database? AND/OR (3) Is the Applicant aware of any others in industry or publications on or about potential buyers and/or prospectors having to sign agreements or agree to nondisclosure of data and or relating to restriction of use on property? AND/OR (4) is Applicant or counsel aware that when one wants to protect "proprietary" data that the use of a confidentiality/non-disclosure agreement is well known? AND/OR (5) In the prospecting industry is it common for it is common for prospectors to agree to an interest owners conditions of restricted use? AND/OR (6) Lastly and maybe most importantly,*** How has the process been manually done; Examiner turns to the 12 page specification and finds that the background is limited; Thus what is the improvement of

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invention besides merely putting on line what was manually done in the past, like a virtual room as taught in Kwok [0010]-[0020].

All of the above knowledge or publications on or before 16 November 2000?

If applicants' answer to anyone of the above 5 questions is "Yes", applicants are required to identify the publication(s)/or requested information and the basis upon which applicants believe that these publications had this capability on or before 16 November 2000.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-10** are rejected under 35 U.S.C. 102(e) as being taught and

anticipated by Pub. No.: US 2002/0188500 A1 (Kwok et al); Provisional

Applications 60/243713 and 60/243712 filed by KWOK which fully support the

PG Pub are attached herein.

3. With respect to **Claim 4** (which is used for purpose of demonstration,

because Examiner determines the claim to be most comprehensive): Kwok

discloses

A method for developing prospects to recover valuable components on

identified property of an interest owner which comprises (see Title):

a. Making available to potential prospecting participants through a computer-based network a first set of property information for the identified property and interest owner conditions under which a potential prospecting participant will submit a proposal for prospecting the property including a compensation schedule for the participant which has at least two options for compensation selectable by the participant and content requirements for the proposal for prospecting (As to the first set of property info being posted see [0020] "viewing industry data including information relating to (prospect or property); as to the participant/user submitting a proposal for prospecting the property including a compensation schedule see [0042] wherein a potential customer can access the data over the internet, wherein another level of access may be granted after being granted approval normally after a user has completed a financial transaction [0027], as to a compensation schedule Given the broadest reasonable interpretation of the claims this is clearly anticipated by Kwok. In paragraph [0006] Kwok teaches "Target exploration properties are bought and sold as "prospects" in whole or fractional interests, based upon the rights involved." That sentence alone is sufficient to fall within the metes and bounds of the claims. The compensation can be fractional or whole, thus two options for compensation. Other compensation schedules are seen in [0009] where by both parties involved in the transaction adopt risk sharing strategies including partnerships, pooling, and joint ventures. Even if Kwok did not teach all

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types of compensation schedules, as it does, it would still teach at least two in that a user of a system can enter the sale (1) or not (2);

b. Receiving by the interest owner through a computer based network from a potential prospecting participant, who has agreed to said interest owner conditions, a proposal for prospecting the property (It is inherent that the prospecting participant has agreed to the interest owner conditions, or otherwise would not have been granted access see [0042] wherein a potential customer can access the data over the internet, wherein another level of access may be granted after being granted approval normally after a user has completed a financial transaction [0027] [0033] and [0043]);

c. Evaluating the proposal for prospecting submitted to the interest owner to determine if it is acceptable to the interest owner ([0033] and [0043] This is also inherent that the interest owner evaluate the proposal and next determine that it is acceptable; this is exactly how it has always occurred as well see [0012]-[0014]);

d. Awarding rights to prospect the property to such potential prospecting participant if the proposal for prospecting is acceptable to the interest owner ([0033] and [0043] Inherent with Kwok that at the end of day if dealing with a "prospect" that rights to drill; etc. will be awarded);

e. Allowing the participant given the award to access through a computer-based network an additional set of property information comprising a detailed property database residing on a computer network controlled by the interest owner to allow such participant to interpret data from the database and prepare

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an interpretation report identifying at least one specific prospect on the property potentially containing valuable components ([0017] [0033] and [0043], all report preparation can be found in [0072] through [0074]);

f. Submitting the interpretation report to the interest owner for evaluation to determine if the interest owner will pursue the prospect ([0033] and [0043] and [0027] and [0028]);

g. If the interest owner declines to pursue the prospect, awarding such participant a limited time opportunity to obtain other interested parties to pursue such prospect with the interest owner ([0033] and [0043] and [0017]); and

h. Providing any compensation required to the participant during any stage of the above according to the compensation schedule (inherent within Kwok [0009] "These arrangements can take place at almost any stage...").

4. With respect to **Claims 2 and 5**: Kwok discloses

wherein said valuable components comprise gas or oil or combination thereof, said database includes seismic data and the interest owner will pursue the prospect by undertaking a well completion to the prospect ([0005] and [0006]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 3,6,8 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwok.

Claims 1-10 are rejected under 35 U.S.C. 103 as being unpatentable over the Kwok reference. Kwok discloses all of the informational features normally provided in a prospecting for a component and purchase of real estate transaction. Further the Kwok reference teaches in [0006] that seismic data/"property information can have significant value, by virtue of the cost of acquiring data, further in [0013] Kwok teaches that the data is proprietary information. Also Kwok teaches making reports from this data [0028] and [0010] "...and other analyses..." Then in [0015] Kwok states a further difficulty relates to security, that is, the owner of the information does not want it to be accessed or duplicated for any unauthorized purpose as it might undermine the value of the information and its selling price and confidentiality enhances the owner's ability of control and gives assurance that the information has retained its value. Kwok arguably does not discuss directly the use of a confidentiality agreement to restrict use of the seismic data and reports prepared therefrom. In determining

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the obviousness of applying what is generally known in the prospecting industry to what is known in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The internet, to one of ordinary skill in the art for sometime now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be for one computer to access and download files from another computer located at a different site than the first. Also, the prospecting industry has utilized confidentiality agreements and prepared property data reports for years to evaluate conditions on a property, risks associated with prospecting and confidentiality agreement is known as a method of keeping of said data "proprietary". Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the Internet to access the data in a separate data base, to have a user sign a confidentiality agreement to review the data, and then said user to prepare a report to evaluate the risks associated with prospecting property. The desirability to do this is clearly to keep data on property confidential so a user may recap testing costs and yet also allow a future buyer to evaluate data and prepare a report to present to future partners.

Response to Arguments

1. Applicant's arguments filed 12/8/06 have been fully considered but they are not persuasive.
2. In reply to: pg 10, middle of page and pg 11 middle of page, Applicant asserts that Kwok fails to teach interest owner conditions and that interest owner

conditions include at a minimum a compensation schedule for the participant with at least two options. Given the broadest reasonable interpretation of the claims this is clearly anticipated by Kwok. In paragraph [0006] Kwok teaches "Target exploration properties are bought and sold as "prospects" in whole or fractional interests, based upon the rights involved." That sentence alone is sufficient to fall within the metes and bounds of the claims. The compensation can be fractional or whole, thus two options for compensation. Other compensation schedules are seen in [0009] where by both parties involved in the transaction adopt risk sharing strategies including partnerships, pooling, and joint ventures. Even if Kwok did not teach all types of compensation schedules, as it does, it would still teach at least two in that a user of a system can enter the sale (1) or not (2).

3. In reply to: pg 10 bottom of the page Applicant asserts that Examiner has associated industry data with property information. This is simply not the case, although the two are not mutually exclusive. If anything Kwok teaches posting all types of "property information" [0017] and [0020].

4. Middle of page 11, in regard to interest owner conditions/compensation schedules is discussed above (#2) and Examiner again states this has not been read out, but only given its broadest reasonable interpretation.

5. In reply to: pg 11 near the bottom of the page Applicant asserts that the money flow taught in Kwok is contrary to that as claimed. This is not true and not contrary at the end of the day the money flows to the owner of the property/ interest owner. The fact that a service administrator is involved in the process is

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irrelevant, as this is just the host of the site and an intermediary for the money to flow through and there is no teaching away that the interest owner or other could not also host the site.

6. In reply to: pg 12 bridging page 13 middle of page Applicant asserts that Kwok fails to teach property information/data be partitioned into a first and second set. This is absolutely not true; Kwok teaches two sets of data "further access" [0027] and [0043] wherein access is granted after approval and as to it being in response to an acceptable proposal for prospecting property, all of the users trying to gain access to data are "potential buyers".

7. In reply to: pg 13 middle of page Applicant incorrectly asserts that Kwok is completely silent regarding the system being even remotely related to a proposal for prospecting property. In fact the whole Kwok reference is about that subject matter. See [0006] "prospects" and [0020]. The whole Kwok reference is about prospecting and speaks of buying. Thus not in direct contradiction and in fact a correspondence and teaching.

8. Applicant's arguments with respect to the 103 rejection have been considered but are moot in view of the recent supreme court case KSR v. Teleflex. Applicant need not have a suggestion or motivation to modify found with in the prior arts. And the statement for a proper 103 that the "prior art reference "must teach or suggest all of the claim limitations" is not true. This being said Examiner now takes time to address the limitations for which the 103 rejection was made.

The Kwok reference teaches in [0006] that seismic data/"property

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information can have significant value, by virtue of the cost of acquiring data, further in [0013] Kwok teaches that the data is proprietary information. Then in [0015] Kwok states a further difficulty relates to security, that is, the owner of the information does not want it to be accessed or duplicated for any unauthorized purpose as it might undermine the value of the information and its selling price and confidentiality enhances the owner's ability of control and gives assurance that the information has retained its value. To this Examiner rejected the claims **3,6,8 and 10** essentially under 103 based upon Kwok and what would have been obvious to one of ordinary skill. To this examiner stated that the use of a confidentiality agreement as a tool to keep data confidential would be will with in the skill of an ordinary artisan. The reason to do so is to clearly keep the information confidential; the benefits of which are demonstrated above, that of the information keeping value. "...[t]he Court has held that a patent for a combination which only unites old elements (Kwok and confidentiality agreement) with no change in their respective functions... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." (KSR) "A person of ordinary skill is also a person of ordinary creativity not an automaton" (Id.)

9. In reply to: bottom of page 14 bridging page 15, Applicant requested a citation of art teaching that use of a confidentiality agreement was known to one of ordinary skill as a tool available to keep information confidential. Examiner has attached CONFIDENTIALITY PACTS REQUIRE GREAT CARE, Steven Elkin to this office action. **Further note the Examiner has asked the Applicant**

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via Rule 105, whether the same was or was not known to applicant in their respective industry.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB
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JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600